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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alex Urich

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EXAMINER

BOUCHELLE, LAURA A

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,473	Applicant(s) URICH, ALEX	
	Examiner LAURA A. BOUCHELLE	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Easley (US 6599271). Easley discloses a device for preventing post occlusion flow surges during eye surgery comprising a tube, a filter housing coupled to the tube, a flow restrictor, and a filter (Abstract). Easley discloses that the flow restrictor can be less than 1.5 mm for a phacoemulsification surgery. The examiner is interpreting the limitation “fixed diameter” to mean that the diameter does not change during use of the device. Although the diameter of the restrictor of Easley can be adjusted to suit the needs of the procedure, it is interpreted that the diameter is “fixed” as it does not change during use; in other words, it is fixed at the appropriate diameter for the duration of the procedure. The limitation “using a flexible and resilient aspiration line...having an inner diameter between 1.5 and 2.5 millimeters” is interpreted as an intended use limitation.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 3, 5, 18, 20, 21, 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley.

5. Claims 3, 18, 21, 24 differ from Easley in calling for the flow restrictor to be located within an output luer attached to the filter housing. Easley discloses the flow restrictor located within the output connector 14 of the filter housing, but fails to teach that the connector is a luer.

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It is well known in the art to connect medical components using luer connectors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the connector of Easley to be a luer connector.

6. Claims 5, 20 differ from Easley in calling for the input tube to have an inner diameter of between 1.5 and 2.5 millimeters. Easley is silent on the diameter of the tubing. Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See MPEP 2144.04. The device of Easley and applicant's invention are used for the same purpose, and therefore, it would be expected that the device of Easley would perform equally well if it had the dimensions as laid out in claims 5, 20.

7. Claims 21, 22 are considered to be product by process claims. These claims are not limited to the manipulations of the recited steps, only the structure implied but the steps. The patentability of a product does not depend on its method of production. See MPEP 2113.

8. Claims 4, 19, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley in view of Maaskamp (US 6149633).

9. Claim 4, 19, 25 differ from Easley in calling for the flow restrictor diameter to be determined by a scaling insert. Maaskamp teaches a flow control system having a flow restrictor having the inner diameter determined by a scaling insert so that the flow of fluid can be precisely controlled. See Fig. 3. Therefore, it would have been obvious to one of ordinary skill in the art

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at the time of invention to modify the device of Easley to have a scaling insert as taught by Maaskamp so that the flow of fluid can be controlled.

Response to Arguments

10. Applicant's arguments filed 2/11/08 have been fully considered but they are not persuasive. Applicant argues that Easley fails to disclose a flow restrictor having a fixed diameter. Easley discloses that the diameter of the flow restrictor is set using a threaded adjustment mechanism. Therefore, the diameter is fixed at any given point during the procedure until it is adjusted by the user. In other words, the diameter does not automatically change based on the condition of the flow of fluid therethrough. The definition of "fixed" according to the Oxford English Dictionary is "in a stable position." There is no mention of the word "fixed" in applicant's disclosure, and therefore, the examiner is using the definition as commonly understood. Since the orifice of Easley does not fluctuate without actively being adjusted by the user, it is interpreted to be in a stable position, i.e. fixed.

11. Applicant further argues that Easley does not teach the use of a flexible aspiration line. The examiner does not agree. Easley teaches that the device may be used with tubing that has a diameter does not expand and contract with changes in pressure. Easley does not state that the tubing is rigid. The tubing is still considered to flexible as it most certainly is bendable so that the handpiece and phaco tip attached to the distal end of the tubing is maneuverable.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA A. BOUCHELLE whose telephone number is (571)272-2125. The examiner can normally be reached on Monday-Friday 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 517-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 3763

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